REMARKS

No claims have been amended. Claims 35 and 36 have been added. Hence, claims 1 – 36 are pending in the application.

Summary of Rejections/Objections

The disclosure was objected to because, on page 15, line 8 of the specification, the term "element 272" is indefinite. The Applicant has reviewed this section of the specification and the related drawings and is unable to determine why the Office Action has found the term to be indefinite. Further clarification is requested.

Claims 6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter claimed.

Claims 1 – 12, 15 – 19, 26 – 32 are rejected under 35 USC 103(a) as being unpatentable over U.S. Publication No. 2002/0016824, herein *Leeds*, in view of U.S. Patent No. 6,161,130, herein *Horvitz*.

Claims 12, 13, 14 and 20 are rejected under 35 *USC* 103(a) as being unpatentable over *Leeds* in view of U.S. Publication No. 2002/0016916, herein *Natarajan*. These rejections are traversed.

Claims 21 – 25, 33 and 34 are rejected under 35 *USC* 103(a) as being unpatentable over *Leeds* in view of U.S. Publication No. 2002/0026634, herein *Shaw*.

REJECTIONS BASED ON 35 USC 112

Claims 6 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter claimed because the term is "signature element" is a relative term, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

The Office Action admits that it is well understood that a signature element is an element of a signature. Furthermore, the Office Action admits that the specification shows how elements are used. Nevertheless, the Office Action finds that this is insufficient for one of ordinary skill in the art to be reasonably apprised of the scope of the invention

Applicant notes that not only does the specification describe, in detail, how the signatures are used, but also describes, in detail, various examples of how they are made. Given all the detail provided for how the signature elements can be used and how they can be made, one skilled in the art would be sufficiently apprised of the scope of the claims to the extent required by 35 USC 112.

REJECTIONS BASED ON PRIOR ART

CLAIMS 1 and 26

The Advisory Action stated that in Applicant's previous response, that Applicant argued limitations that were not supported by the claims. Presumably, the Advisory Action is referring to the argument in which applicant states that claim 1 recites a system that "automatically determines what particular content to use to classify electronic mail messages as, for example, bulk mail, by automatically determining that a quantity (i.e. threshold value) of electronic mail messages received over a network have the same particular content." Applicant, however, believes that the argument did in fact argue limitations that are in the claims.

Claims 1 and 26 recite:

automatically generating a set of criteria based on contents of a plurality of electronic mail messages received over a network;

wherein the step of automatically generating a set of criteria includes, in response to determining that a threshold number of said plurality of electronic mail messages have a particular content, generating criteria that classifies

electronic mail messages that have said particular content as a first type of electronic mail;...

While the argument made by applicant, taken literally, does not argue limitations that are word for word direct quotations from the claims, the argument restates claims 1 and 26 in a way the accurately reflects the limitations of claims 1 and 26. Specifically, claims 1 and 26 literally require "automatically generating" "criteria that classifies electronic mail messages that have said particular content as a first type of electronic mail", by "determining that a threshold number [i.e. a quantity] of said plurality of electronic mail messages have [the] particular content." By requiring "generating criteria that classifies electronic mail messages that have said particular content as a first type of electronic mail," claims 1 and 26 require, as argued, a system that "automatically determines what particular content to use to classify electronic mail messages." Further, by generating such criteria "in response to determining that a threshold number of said plurality of electronic mail messages have a particular content," claims 1 and 26 require, as argued, a system that "automatically determines what particular content to use to classify electronic mail messages" by "automatically determining that a quantity (i.e. threshold value) of electronic mail messages ... have the same particular content". Thus, the claims support the limitations applicant argued render claims 1 and 26 patentable.

For the sake of argument, however, Applicant provides an argument proving patentability using language that more literally follows the limitations. As mentioned before, *Leeds* and *Horvitz* describe a system that classifies electronic mail messages based on particular content contained therein, where the particular content has been predetermined to be indicative of junk mail. For example, *Leeds* teaches that electronic mail messages that include certain phrases and keywords in the message body (0026, 0034) can be classified as junk electronic mail messages. *Horvitz* teaches that electronic mail messages that have particular content in the form of, for

example, particular words can be classified as junk electronic mail messages. (col. 4, lines 54 – 60, "In accordance with our specific inventive teachings, each incoming e-mail message, in such a stream, is first analyzed to determine which feature(s) in a set of N predefined features, i.e., distinctions, (where N is an integer), that are particularly characteristic of spam, the message contains. These features (i.e., the 'feature set') include both simple-word-based features and handcrafted features.")

While the cited art teaches using particular content as criteria for classifying the electronic mail messages, it fails to suggest in any way the particular claimed way of automatically determining what particular content to use as criteria for classifying electronic mail messages, and in particular, fails to suggest in any the claimed way of automatically determining that particular content is contained in a threshold number of electronic mail messages, and in response, generating criteria that classifies electronic mail messages that have the particular content as a first type of electronic mail. More specifically, the cited art fails to suggest in any way "determining that a threshold number of said plurality of electronic mail messages have a particular content", and "in response to" making this determination, "generating criteria that classifies electronic mail messages that have said particular content as a first type of electronic mail."

As shown above, the cited art does not disclose or suggest in any way all the limitations of claims 1 and 26. Therefore, claims 1 and 26 are patentable. Reconsideration and allowance of claims 1 and 26 is respectfully requested.

NEW CLAIM 35

Claim 35 recites:

A method of managing electronic mail, the method comprising the steps of:

automatically generating a set of criteria based on contents of a plurality of electronic mail messages received over a network;

wherein the step of automatically generating a set of criteria includes **automatically determining what particular content to use to classify electronic mail messages by performing steps that include** determining that a threshold number of said plurality of electronic mail messages have a particular content;

in response to determining that a threshold number of said plurality of electronic mail messages have said particular content, generating criteria that classifies electronic mail messages that have said particular content as a first type of electronic mail;

In alleging that the argument for claims 1 and 26 argue limitations not supported by the claims, the Advisory Action relies on the assertion in the argument that the claims require a system that "automatically determines what particular content to use to classify electronic mail messages" as being the particular limitation unsupported by claims 1 and 26. To clearly obviate this allegation, a new claim 35 is provided, the new claim 35 not only including the limitations of claims 1 and 26 but the limitation allegedly missing (see embolden portion). Thus, for at least the reasons given with respect to claims 1 and 26, it is respectfully submitted that claim 35 is patentable. Allowance of claim 35 is respectfully requested.

CLAIMS 10 AND 29

Claims 10 and 29, as amended, recite:

an electronic mail server determining whether said message signature satisfies a set of criteria based on message signatures previously received by said central server from a set of electronic mail servers; and

wherein said set of criteria classifies said electronic mail message and a threshold number of electronic mail messages as having a particular content;...

The cited art fails to disclose or suggest in any way all the limitations of claims 10 and 29, recited above. As stated with respect to limitations in claims 1 and 26, the cited art fails to disclose or suggest in any way "generating criteria that classifies electronic mail messages that have [a] particular content as a first type of electronic mail" "in response to determining that a threshold number of said plurality of electronic mail messages have [the] particular content". For similar reasons, the cited art would also fail to disclose or suggest in any way "an electronic mail server determining whether said message signature satisfies a set of criteria based on message signatures previously received", where the "set of criteria [that is] based on the message signatures previously received" is used to "[classify] said electronic mail message and a threshold number of electronic mail messages as having a particular content." Therefore, claims 10 and 29 are patentable. Reconsideration and allowance of claims 10 and 29 is respectfully requested.

CLAIMS 19 AND 32

Claims 19 and 32 recite:

determining whether said message signature satisfies a set of criteria that indicates said electronic mail message and a threshold number of electronic mail messages have a particular content;...

The cited art fails to disclose or suggest in any way all the limitations of claims 19 and 32. For example, the cited art fails to disclose or suggest in any way the limitation of "determining whether said message signature satisfies a set of criteria that indicates said electronic mail message and a threshold number of electronic mail messages have a particular

content". As stated with respect to limitations in claims 1 and 26, the cited art fails to disclose or suggest, "generating criteria that classifies electronic mail messages that have [a] particular content as a first type of electronic mail" "in response to determining that a threshold number of said plurality of electronic mail messages have [the] particular content". For similar reasons, the cited art would also fail to disclose or suggest in any way "determining whether said message signature satisfies a set of criteria that indicates said electronic mail message and a threshold number of electronic mail messages have a particular content", as claimed. Therefore, claims 19 and 32 are patentable. Reconsideration and allowance of claims 19 and 32 is respectfully requested.

CLAIMS 15 AND 31

Claims 15 and 31, recite:

> counts of how many times said one or more signature elements are matched by signature elements from message signatures generated for other electronic mail messages.

The cited art fails to disclose or suggest in any way all the limitations of claims 15 and 31. For example, the cited art fails to disclose or suggest in any way the limitation of "counts of how many times said one or more signature elements are matched by signature elements from message signatures generated for other electronic mail messages."

The Final Office Action stated that the confidence ratings described in *Leeds* in the following section discloses or suggests a "server generating counts of matching signature elements of the emails."

> The method and system of the present invention assign confidence ratings to messages to signify the statuses of the messages as junk e-mails or as a bona fide messages that the recipient may wish to read. The method and system begin by

analyzing the origins and transmission paths of the messages. The sender's origination information is extracted from the e-mail message and an automatic reply (called a verification request) is created and sent. Based on the verification response that is received in response to the verification request, the sender is scored as to the probable characteristics, origination, validity, and desirability of the mail. Incoming messages (e-mails) are automatically scanned and parsed, either (1) at a server located at an Internet provider (prior to delivery to the intended ultimate recipient), (2) at a LAN-based receiving station, or (3) at the actual ultimate recipient's mail machine, i.e., local to the user. Once the message has been parsed or broken down into fields, the message is compared with several user defined rules for handling messages, and a confidence rating is assigned to the message. In one embodiment, the message header information is analyzed and a verification request(s) is/are automatically sent to the purported sender(s), as identified by fields such as "From:" or "Reply-To:". If there is a delivery problem in delivering the verification request, the presumed validity of the message is reduced in accordance with a set of user-definable criteria. In addition to determining the purported origination point, the present invention automatically analyzes all information pertaining to the sender, the path of delivery, any information pertaining to copies, blind copies, or other indicia of validity of the origin of the message to determine if there has been a discernable effort to obscure the origin, disguise the sender, or in some other way to inhibit the recipient from performing verification of the sender's identity. For example, if a message has purportedly been relayed through a machine named mail.fromnowhere.com and the mail handling system has determined that such a

machine does not actually exist, the confidence rating for the message should be decreased. (Leeds, 0024)

As is easily discerned from a reading of the above section, *Leeds* does not disclose or suggest in any way that the confidence ratings are based on or are in any way related to "counts of how many times said one or more signature elements are matched by signature elements from message signatures generated for other electronic mail messages." In fact, this limitation is not disclosed or suggested by anything else in this section or any other teaching of *Leeds*.

Furthermore, *Horvitz* does not suggest in any way this limitation. Neither has the Office Action so alleged.

As shown above, not all the limitations of claim 15 are disclosed or suggested by the cited art. Therefore, claims 15 and 31 are patentable.

DEPENDANT CLAIMS

The pending claims not discussed so far are dependant claims that depend on an independent claim that is discussed above. Because each of the dependant claims include the limitations of claims upon which they depend, the dependant claims are patentable for at least those reasons the claims upon which the dependant claims depend are patentable. In addition, the dependent claims introduce additional limitations that independently render them patentable. However, due to fundamental differences already identified, the additional limitations are not discussed at this time.

For the reasons set forth above, Applicant respectfully submits that all pending claims are patentable over the art of record, including the art cited but not applied. Accordingly, allowance of all claims is hereby respectfully solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Dated: March 24, 2003

Marcel K. Bingham
Reg. No. 42,327

1600 Willow Street
San Jose, CA 95125
Telephone No.: (408) 414-1080 ext.206
Facsimile No.: (408) 414-1076

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